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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,391	02/11/2004	Mitchell A. Altman	BIGTOE.003A	3924
20995	7590	12/27/2006	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			HOLLOWAY III, EDWIN C	
			ART UNIT	PAPER NUMBER
			2612	
SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE		DELIVERY MODE	
3 MONTHS	12/27/2006		ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 12/27/2006.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)
	10/776,391	ALTMAN, MITCHELL A.
	Examiner	Art Unit
	Edwin C. Holloway, III	2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 October 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 20-28,31,33,35,39 and 42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 20-28, 31, 33, 35, 39, 42 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) ✓ | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

EXAMINER'S RESPONSE

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3-16-06 has been entered. The examiner has considered the new presentation of claims and applicant's arguments in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 35 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one

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skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The public place in claim 35 is not disclosed.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 20-28, 31, 33, 35, 39, ^{and} 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 20 line 14, "said one of the remotely controlled televisions" lacks proper antecedent bases. In claim 35 lines 14-15 the public place is unclear because prior references to public place in the claim were deleted by the last amendment. It is unclear if applicant intended to remove public place from the claim intended the claim to be limited to a public place.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 20-24, 26-28, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667) in combination with Fridley (US 6005486), Rumbolt '359 (US 4703359)

and Rumbolt '511 (US 4774511).

Regarding claim 20, Enomoto discloses a method of effecting a function of a remotely controlled device including pointing a universal remote device 1 in the direction of (directed toward) the remotely controlled device in col. 3 lines 25-32 and col. 5 lines 42-56. The remote device includes a database of encoded signals for effecting control of a plurality of different device in the form of a lookup table in ROM 64 disclosed in col. 6 lines 45-53. The devices are TV's in col. 4 line 9. Actuating an actuator (operating/depressing keys 2/3) to cause emitting of the encoded signals from the database is disclosed in col. 3 lines 25-32 and col. 5 lines 42-56. Emitting the encoded signals by an emitter 82 is disclosed in col. 6 lines 54-68. Without selecting a set of control signals is included in col. 6 lines 1-9). Enomoto does not expressly state that there is less than 1/2 second between each encoded signal, but fig. 4 and col. 4 lines 46-53 and col. 5 lines 36-39 suggests .0006 to .0018 seconds between signals. Further, fig. 1 shows gap between codes A,B,C of less than the codes that are about .021 seconds ($12 * (.0012 + .0006)$). Enomoto does not expressly disclose that the ROM stores signals for twenty different TV's, but discussion of ROM in col. 4 lines 11-25 refers to Rumbolt '359 which incorporates by reference Rumbolt '511 having memory for 64 TV signals.

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Fridley discloses transmitting a sequence or cluster of signals with 40 ms (less than 1/10 sec or 100 ms) delay between command in col. 19 lines 12-22.

Rumbolt '359 is referred to by Enomoto for disclosing the ROM storing the signal lookup table. Rumbolt disclosed in col. 7 line 50 that the ROM includes data for most widely used formats.

Rumbolt '511 discloses a memory table storing 64 TV signal formats in col. 3 line 15 and is incorporated by reference in Rumbolt '359 for such memory operation in col. 2 lines 64-67 and col. 7 lines 7-20.

Regarding claim 20, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Enomoto twenty different TV signals in view of Rumbolt '511 disclosing memory table for storing 64 TV signal formats because Enomoto refers to Rumbolt' 359 in discussing the memory and Rumbolt '359 incorporated by reference to Rumbolt '511 for the memory. Although Enomoto shows only 3 TV's, this example is not limiting and more codes are suggested by the reference to "several devices" in col. 6 line 9 of Enomoto indicating that the remote controller of Enomoto is capable of controlling more than three different TV's in range and because col. 4 lines 11-26 of Enomoto refers to Rumbolt for the signal

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ROM where in Rumbolt '359 the ROM includes formats for most widely used appliances that would obviously include twenty signals since Rumbolt '359 incorporates by reference to Rumbolt '511 having memory for 64 TV signal formats. The less than 1/2 second between signals would have been obvious in view of the 40ms delay in Fridley for rapid and flexible operation and suggested by the short spaces between signals in fig. 1 and lack of delay in fig. 4 of Enomoto.

Regarding claim 21 and 39, Enomoto discloses transmitting the signal 3 but claim 7 of Enomoto includes only one command signal for each of the plurality of devices. Further, Fridley discloses transmitting a sequence or cluster of signals only once for eliminating a selection switch with very rapid operation. See col. 9 line 48 - col. 10 line 9 and col. 12 lines 16-34 of Fridley. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Enomoto the emission of the cluster only once as disclosed in Fridley for rapid operation and suggested by claim 7 of Enomoto.

Regarding claim 22, emitter 82 of Enomoto is an infrared LED in col. 6 lines 59-60.

Regarding claim 23, pointing at a second device and repeating the actuating and emitting steps is disclosed in col.

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5 lines 57-66 of Enomoto.

Regarding claims 24, the function includes OFF in col. 5 line 48 of Enomoto.

Regarding claim 26-28, repeating the operation to reverse the function between ON and OFF is disclosed in col. 12 lines 49-57 of Fridley and it would have been obvious to have included this operation in Enomoto because the "ON or OFF" function in Enomoto suggests this toggle operation and col. 12 lines 49-57 of Fridley states that this is common in TV codes.

8. Claims 25 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667) in combination with Fridley (US 6005486), Rumbolt '359 (US 4703359) and Rumbolt '511 (US 4774511) as applied above and further in view of Murray (US 6778380B2).

Regarding claim 25, Enomoto discloses volume decrement control in col. 3 line 68, but lacks mute control.

Murray discloses a television remote control device and method with a single function of mute to overcome the distraction of a TV when communicating to a nearby person in col. 1 lines 15-25. The single function transmitter is small and inexpensive. See col. 2 lines 27-60. It would have been obvious to one of ordinary skill in the art at the time the

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invention was made to have included the mute function Murray in the combination applied above to toggle between reduced and normal sound level, suggested by the volume decrement of Enomoto to reduce distractions

Regarding claims 33, a single function remote would have been obvious in view of Murray to provide a small and inexpensive remote.

9. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667), Fridley (US 6005486), Rumbolt '359 (US 4703359), Rumbolt '511 (US 4774511) and Murray (US 6778380B2) as applied above and further in view of Carlsgaard (US 20020186320A1).

The combination applied above has mute, but not closed caption.

Carlsgaard discloses providing closed captioning automatically with a mute command in paragraph 0025. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the closed caption function in the combination applied above in view of Carlsgaard disclosing automatically providing closed caption with the mute command.

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10. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667), Fridley (US 6005486), Rumbolt '359 (US 4703359) and Rumbolt '511 (US 4774511) as applied above and further in view of van Ee (US 6208341B1).

Van Ee discloses a remote control where a programmable delay of 0.1 to 99.9 seconds is provided between commands in col. 2 lines 20-40. A delay of 0.5 seconds is default, but can be changed as desired in col. 4 lines 8-48. The 1/4 to 1/2 second delay of claim 17 would have been obvious in the combination applied above because Van Ee discloses a programmable delays in remote transmitter covering this range to allow desired delays and is suggested by col. 19 lines 34-39 of Fridley disclosing that various different delays may be used.

11. Claims 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667) in combination with Fridley (US 6005486), Rumbolt '359 (US 4703359) and Rumbolt '511 (US 4774511) as applied above and further in view of Mullaly (US 6567032B1) and Murray (US 6778380B2).

Regarding claim 35, Enomoto discloses a method of effecting a function of a remotely controlled TV's including pointing a universal remote device 1 in the direction of (directed toward) the remotely controlled TV in col. 3 lines 25-32 and col. 5

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lines 42-56. Plural devices in a place is disclosed in col. 2 lines 27-47 and plural TV's in col. 3 lines 63-64. The remote device includes a database of encoded signals for effecting control of a plurality of different device in the form of a lookup table in ROM 64 disclosed in col. 6 lines 45-53. Actuating an actuator (operating/depressing keys 2/3) to cause emitting of the encoded signals from the database is disclosed in col. 3 lines 25-32 and col. 5 lines 42-56. Emitting the encoded signals by an emitter 82 is disclosed in col. 6 lines 54-68. Without knowing the set of control signals is included in col. 6 lines 1-9). Enomoto discloses volume decrement control in col. 3 line 68, but lacks mute control and lacks public place and minimize disturbance.

Murray discloses a television remote control device and method with a single function of mute to overcome disturbance of a TV during load commercials or when communicating to a nearby person in col. 1 lines 15-25. The single function transmitter is small and inexpensive. See col. 2 lines 27-60.

Mullaly discloses a pointing remote control for use in a public place with out pre-programming in col. 8.

Regarding claim 35, the limitations of twenty TV signals and less than 1/2 seconds would have been obvious for the same reasons applied above to claim 20. It would have been obvious

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to one of ordinary skill in the art at the time the invention was made to have included the minimizing of disturbance and mute function Murray in the combination applied above to toggle between reduced and normal sound level, suggested by the volume decrement of Enomoto to reduce distractions with a small and inexpensive remote. Public place would have been obvious in view of Mullaly disclosing the desirability of using a remote control in a public place without pre-programming and because the signals of Enomoto would not know they are being used in a public place.

Response to Amendment

12. The declaration under 37 CFR 1.132 filed 3-16-06 is insufficient to overcome the rejection of claims 1-3 and 7-34 based upon prior art as set forth in the last Office action because: There is no clear nexus between the declaration and the claims. See MPEP 716.03 Commercial success must be commensurate with the scope of the claims. Evidence of commercial success that broadly covers the claims is not commensurate with the scope of the claims. See MPEP 716.03(a) The declaration refers to a single function of TV on/off, but claims 20 and 35 are not limited to a single function. Claim 20 does not limit the function to on/off will 35 includes off or mute. The device in the declaration includes 117 codes, but the

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claims and specification are not limited to this. 117 codes may broadly include the 20 codes of the claims, but 117 is significantly larger. This is not commensurate with the scope of the claims. The device in the declaration has a timing of 205 m sec, is significantly smaller than the 500 m sec of claims 20 and 30 and 205 ms is not in the range of claim 31. The declaration refers to a document with features such as instant reactivation, bigger battery and flashing LED that are not claimed. There is no comparison to the sales of other universal remotes. See MPEP 716.03((b)(IV). The claimed limitations are properly rejected as unpatentable over the prior art.

Response to Arguments

13. Applicant's arguments filed 10-6-06 have been fully considered but they are not persuasive or are moot in view of the new grounds of rejection.

Applicant argues that the prior art specifically selects the encoded signals and therefore lacks the limitation of without selecting or knowing a set of control signals. This argument is not persuasive because Enomoto discloses sending a series of control signals without selecting/knowing the particular control signal in the series of control signals that controls the particular TV to which the remote is pointing in col. 6 lines 1-9).

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The argument regarding the annoying problem of trying to have a conversation in a location where a TV is powered on is not persuasive in view of col. 1 lines 18-22 of Murray.

The argument that "at least twenty devices" is a critical parameter to allow control of a majority of televisions is not persuasive because this value would have been obvious in view of Enomoto referring to Rumbolt '359 that refers to Rumbolt '511 for the lookup table ROM for 64 signal formats. Applicant argues that the examiner dismissed the number of twenty TV's as not critical. This argument is not persuasive because the number of 64 TV formats in Rumbolt '511 would include the twenty TV signals of the claims.

The argument that Enomoto and Rumbolt are designed to be programmed to operate a particular device is not persuasive because Enomoto transmits a series of TV control signals without selecting or knowing which of signals will control the TV at which the universal remote is pointing. Applicant argues that after a programming step, Enomoto emits only a single signal that operates the device to which it is programmed. Applicant is mistaken. Enomoto transmits a series of signals without a programming step to select a single signal.

The argument that Enomoto and Rumbolt require more than 1/2 second between signals to avoid confusion is not persuasive

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because no such limitation required in the patents. Rumbolt '359 has an inter command fill time delay, but does not state that this value is more than 1/2 second. Enomoto does not specify any delay and shows a gap less than .021 sec (.0012 + .0006) in fig. 1. Further, Fridley teaches .04 sec delay in fig. 7. Applicant dismisses van Ee as having no impact because it would not suggest that conventional remote control devices could be controlled with such short time periods between signals. This argument is not persuasive because Enomoto shows such short time periods, providing motivation for short time periods and Rumbolt does not expressly exclude short time periods. Fridley also teaches such short time periods with motivation of rapid operation.

The 1/4 to 1/2 second range would have been obvious in view of van Ee and is not covered by applicant's declaration.

The argument that the claimed number of signals and time between signals are critical parameters in view of the original claims is not persuasive because original claims 4-5 and 16-17 claimed different parameters. Original claims 4-5 and 16-17 are evidence that the parameters are not critical.

The argument that the number of signals and time between signals are patentable is not persuasive because these parameters would have been obvious in view of the applied

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combination.

Enomoto does not have the critical programming problem argued by applicant.

The argument that twenty signals are critical to overcome the "annoying problem" of not turning off a substantial number of devices is not persuasive because Rumbolt '511 includes at least twenty signals. Further, this problem is not claimed and this number is not in applicant's declaration.

Applicant's arguments regarding the evidence of commercial success are not persuasive for the reasons stated in item 12 of this action. See MPEP 716.03. Applicant argues that "the commercial success of the product does not rest on the specific number of devices affected, nor on the specific timing of the signals." In that case, the examiner's position is that there is no nexus as the evidence of commercial success does not establish that the commercial success is due to the claimed features and not unclaimed features. Turning off TV's when the signal for turning off that TV cannot be known in advance is not persuasive because Enomoto anticipates this feature and this feature is not stated in the declaration. Applicant appears to argue that the sold devices meet the critical parameters, but applicant's evidence does not establish commercial success "commensurate with the scope of the claims" as required by MPEP

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716.03(a). Further, applicant must show that the claimed features were responsible for the commercial success (inventors opinion is insufficient) in MPEP 716.03(b).

Applicant argues that comparison to sales of other universal remotes is not relevant because the device does not compete with other universal remotes. This argument is not persuasive because MPEP 716.03(b)(IV) states that gross sales figures do not show commercial success absent evidence as to market share, or as to the time period during which the product was sold, or as to what would normally be expected in the market.

Lack of marketing does make alone make a clear nexus. Proof that the commercial success is attributed to the claimed limitations is needed. Further, the newspaper and magazine articles amount to free advertisement that would increase sale even if applicant did not pay for marketing. The argument that the articles establish nexus by motivating the public to carry out the methods presently claims is not persuasive because the articles are not commensurate with the scope of the claims.

MPEP 716.03(a)(I.) states that commercial success must be due to the claimed features, not due to unclaimed features. But the declaration refers to a document with unclaimed features such as instant reactivation, bigger battery and flashing LED.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Amano (US 4999622) discloses a universal remote with 40 signals.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

CONTACT INFORMATION

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact an Electronic Business Center (EBC) representatives at 571-272-4100 or toll free at 1-866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at ebc@uspto.gov. The Patent EBC is a complete customer service center that supports all Patent e-business products and service applications. Additional information is available on the Patent EBC Web site at <http://www.uspto.gov/ebc/index.html>.

Any inquiry of a general nature should be directed to the Technology Center 2600 receptionist at (571) 272-2600. Facsimile submissions may be sent via central fax number 571-273-8300 to customer service for entry by technical support staff. Questions related to the operation of the facsimile system should be directed to the Electronic Business Center.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (571) 272-3058. The examiner can normally be reached on M-F (8:30-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on (571) 272-7308.



EDWIN C. HOLLOWAY, III
PRIMARY EXAMINER
ART UNIT 2612

EH
12/19/06